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EXAMINER

SANTIAGO CORDERO, MARIVELISSE

ART UNIT

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2617

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/521,788	Applicant(s) ROUCHY ET AL.	
	Examiner MARIVELISSE SANTIAGO-CORDERO	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 12, 14-20, 22, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 12, 14-20, 22, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/4/2008 has been entered.

Response to Arguments

2. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 11-12, 14-20, 22, and 34-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 11 recites the limitations “detecting an entrance of an output device within a communication range” and “without user intervention”. Applicant stated that support for the limitations is found on page 6, lines 22-37 and page 8, last paragraph of the specification

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(Remarks: page 7, last paragraph). Applicant further stated that while the application does not explicitly refer to “detection an entrance within the communication range” and “without user intervention”, one of ordinary skill in the art would understand these to be inherent from the above-cited portions (Remarks: page 7, last paragraph).

Regarding the limitation "detecting an entrance of an output device within a communication range", the specification discloses the communication module sending out interrogation messages with a range of a few meters (page 6, lines 22-26) and if an output device subsequently passes near the information retransmission device, it responds to the interrogation messages with the result that its presence is automatically detected (page 6, lines 27-31). However, sending interrogation messages with a range of a few meters and passing near a device with the result of automatically detecting the presence is not the same as detecting an entrance of an output device within a communication range. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. See MPEP 2163.07(a). Detecting an entrance of an output device is not necessarily present when the device passes near an information retransmission device with the result of automatically detecting the presence, but it is a mere probability or possibility. Presence is a broad term that does not inherently (or necessarily) require detection of an entrance within a range, if entrance is defined as a physical movement (note that such definition is also not supported in the original specification). Therefore, the limitation " detecting an entrance of an output device within a communication range " was not described in the specification in such a

way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding the limitation “without user intervention”, the Examiner did not find support for this limitation in the specification. According to the Applicant, the invention includes automatic retransmission immediately upon detection of the entrance of the device within communication range and thus does not require an action by the user, except moving with the communication range (Remarks: page 8, last paragraph). This is contradictory. It appears that the invention does require user intervention, i.e., moving with the communication range (as admitted by applicant). Furthermore, the specification, in page 8, lines 7-12 discloses an embodiment wherein the output device is a television (8d). In such embodiment, it discloses that when the television 8d is switched on it is detected automatically and the information is automatically retransmitted to it. It appears that user intervention is required for the television to be switched on. As a result, the limitation "without user intervention" is contradictory to Applicant's disclosure, and therefore, was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 35, the limitation “without intervention of a user of said nearby output device” was not disclosed in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention as explained above.

Applicant is welcomed to point out where in the specification the Examiner can find support for this limitation, if Applicant believes otherwise.

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 12, 18, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 12, it is not clear how said means for exchanging are adapted to interrogate the remote server on detection of said output device in order to receive information from said server and retransmit it directly to said detected device. Note that claim 11, from which claim 12 depends, requires detecting said output device once the information received from said remote server has been stored. Thus, it is unclear how, on detection, the server is interrogated in order to receive information if the information has already been received and stored in the information retransmission device. Appropriate correction is required.

Claim 18 recites the limitation "said means for automatically detecting the presence of an output device" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 22 recites the limitations "the telephone jack" in line 3 and "the power" in line 6. There is insufficient antecedent basis for this limitation in the claim. For examination on the merits and to be consistent with claim terminology, claim 22 will be assumed to depend from claim 34. Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 11-12, 14-15, 17-20, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Shibazaki et al. (hereinafter "Shibazaki"; JP 11-88416).

Regarding claim 11, Shibazaki discloses an information retransmission device (Fig. 1, references 5P, 5Q, and/or 5R; Abstract; note the information relay device) comprising:

means (21) for exchanging information (Abstract; paragraphs [0010]-[0011] and [0024]) with a remote server (4) (Fig. 1, reference 3) via a switched telecommunications network (6) (Fig. 1, reference 1);

means (22) for storing information received from said remote server (Fig. 1, reference 63; note the accumulation means; paragraphs [0010]-[0011], [0018], and [0029]-[0030]);

a communications module (Fig. 1, reference 61) having a communication range (Abstract; note the range), for establishing a wireless radio connection within the communication range (Abstract; paragraph [0021]; note the electromagnetic waves of an electric wave, infrared rays, etc.);

means (23) (paragraph [0025; note the detection means) for automatically detecting an entrance of an output device (8) (Fig. 1, references 71, 72, and/or 73; paragraph [0039]) within the communication range (Abstract; paragraphs [0025], [0029]-[0030], [0039]; note the detection means detecting when the information portable terminal enters a communication possible range) once the information received from said remote server has been stored in said means for storing information (paragraphs [0010]-[0011], [0018], [0029]-[0030]); and

means (23) for automatically retransmitting the stored information from said information retransmission device (2) to said output device (8) immediately upon detection of the entrance of

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said output device within the communication range by said means for automatically detecting (paragraphs [0010]-[0011], [0025]-[0026], and [0029]-[0030]), without intervention of a user of said output device (Abstract; paragraph [0032]; note the “without bothering a user” in the “Problem to be Solved” section).

Regarding claim 12, Shibazaki discloses a device according to claim 11 (see above), wherein said means (21) for exchanging information are adapted to interrogate said remote server (4) via aid telecommunications network (6) on detection of said output device (8) in order to receive information from said server (4) and retransmit it directly to said detected output device (8) (Abstract; paragraphs [0007], [0025]-[0026]).

Regarding claim 14, Shibazaki discloses a device according to claim 11, comprising means (25) for setting its operating parameters enabling a user and/or the remote server (4) to set parameters for retransmission of received information as a function of the identity of the detected output device (8) (paragraphs [0014]-[0017], [0031], [0044]; note the parameter of erasing and/or eliminating unnecessary and redundant information).

Regarding claim 15, Shibazaki discloses a device according to claim 14, further comprising means (26) for selecting and/or converting received information in order to enable the retransmission of some or all of said information in a format suited to output on the detected output device (8) (paragraphs [0025] and [0041]; note that the accumulated information is identified by an ID number assigned to the PDA and thus selected when the PDA is detected; in addition that signal transduction (fairly characterized as converting the information) is performed).

Regarding claim 17, Shibazaki discloses a device according to claim 11 (see above), being adapted to exchange information with said output device (8) by means of a wireless radio connection (paragraphs [0021] and [0039]).

Regarding claim 18, Shibazaki discloses a device according to claim 17 (see above), exchanging information with said output device (8) in accordance with a standard information transmission protocol (paragraphs [0021] and [0039]; note the electromagnetic waves of an electric wave, infrared rays, etc.; note that infrared is inherently in accordance with a standard information transmission protocol) and said means for automatically detecting the presence of an output device (8) nearby and said means for automatically retransmitting information take the form of a communications module (23) using the standard information transmission protocol (paragraphs [0021] and [0039]; note the electromagnetic waves of an electric wave, infrared rays, etc. and that the communications module is inherently present in infrared transmissions).

Regarding claim 19, Shibazaki discloses an information retransmission system (Fig. 1; paragraph [0021]) comprising a device (2) (Fig. 1, references 5P, 5Q, and/or 5R; Abstract; note the information relay device) for retransmitting information received from a remote server (4) (Fig. 1, reference 3; Abstract; paragraphs [0010]-[0011] and [0024])) over a telecommunications network (6) (Fig. 1, reference 1) in order to retransmit it to a output device (8) (Fig. 1, references 71, 72, and/or 73; paragraphs [0010]-[0011], [0025]-[0026], and [0029]-[0030]) comprising means for receiving information coming from said information retransmission device (2) (Abstract; paragraphs [0010]-[0011], [0025]-[0026]) and means for output of that information (paragraphs [0002], [0006], and [0040]; note the displaying or reproducing of information),

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wherein said device (2) for retransmitting information is the information retransmission device according to claim 11 (see above).

Regarding claim 20, Shibazaki discloses a system according to claim 19, wherein said output device (8) is an output device selected from the group consisting of:

- a mobile telephone (8a);
- a personal digital assistant (8b);
- a watch (8c);
- a television (8d); and
- a portable computer (8e) (paragraph [0002]).

Regarding claim 35, Shibazaki discloses an information retransmission device (Fig. 1, references 5P, 5Q, and/or 5R; Abstract; note the information relay device) comprising:

means (21) for exchanging information (Abstract; paragraphs [0010]-[0011] and [0024]) with a remote server (4) (Fig. 1, reference 3) via a switched telecommunications network (6) (Fig. 1, reference 1);

means (22) for storing information received from said remote server (Fig. 1, reference 63; note the accumulation means; paragraphs [0010]-[0011], [0018], and [0029]-[0030]);

means (23) (paragraph [0025; note the detection means) for automatically detecting the presence of a nearby output device (8) (Fig. 1, references 71, 72, and/or 73; paragraphs [0025], [0029]-[0030], and [0039]); note the detection means detecting when the information portable terminal enters a communication possible range) once the information received from said remote server has been stored in said means for storing information (paragraphs [0010]-[0011], [0018], [0029]-[0030]); and

means (23) for automatically retransmitting the stored information from said information retransmission device (2) to said nearby output device (8) immediately upon initial detection of the presence of said nearby output device by said means for automatically detecting (paragraphs [0010]-[0011], [0025]-[0026], and [0029]-[0030]), without intervention of a user of said nearby output device (Abstract; paragraph [0032]; note the “without bothering a user” in the “Problem to be Solved” section).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shibazaki in view of Suoknuuti et al. (hereinafter “Suoknuuti”; cited in form PTO-892, paper no. 20060728).

Regarding claim 16, Shibazaki discloses a device according to claim 11 (see above), but fails to specifically disclose also being connected to at least one standard telephone device (10) and comprises means (27) for identifying the addressee of an incoming call and means (28) for switching calls in order to enable the switching of incoming calls between said at least one standard telephone device (10) and said information exchange means (21).

However, in the same field of endeavor, Suoknuuti discloses an information retransmission device (Fig. 1, reference 20) also being connected to at least one standard telephone device (10) (Fig. 1, reference 32; col. 2, lines 54-57) and comprises means (27) for identifying the addressee of an incoming call (col. 4, lines 29-34) and means (28) for switching

calls in order to enable the switching of incoming calls between said at least one standard telephone device (10) and said information exchange means (21) (col. 3, lines 32-36; col. 4, lines 29-39).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to connect the device of Shibazaki to at least one standard telephone device and comprising means for identifying the addressee of an incoming call and means for switching calls in order to enable the switching of incoming calls between said at least one standard telephone device and said information exchange means as suggested by Suoknuuti for the advantages of increasing the versatility of the device and enabling the efficient routing of calls.

11. Claims 34 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibazaki in views of Phillips et al. (hereinafter "Phillips"; cited in form PTO-892, paper no. 20060728) and Bear et al. (Pub. No.: US 2006/0006230).

Regarding claim 34, Shibazaki discloses the device according to claim 11 (see above), but fails to specifically disclose wherein said information retransmission device is provided with power exclusively from a connection the telecommunications network (6) and is integrated into a telephone jack.

However, in the same field of endeavor, Phillips discloses providing power exclusively from a connection to the telecommunications network (col. 1, lines 34-50).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to provide to the information retransmission device of Shibazaki with power exclusively from a connection to the telecommunications network as suggested by Phillips

for the advantages of not losing telephony services in case of a power outage (Phillips: col. 1, lines 34-50), reducing the volume of the information retransmission device, no extra power supply is required, installation becomes much simplified, and it's cost-effective.

In addition, Shibazaki in combination with Phillips fail to specifically disclose integrated into a telephone jack.

However, in the same field of endeavor, Bear discloses an information retransmission device integrated into a telephone jack (Fig. 5; paragraph [0070]; note that the wall socket reads on the claimed telephone jack).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to integrate the information retransmission device of Shibazaki in combination with Phillips into a telephone jack as suggested by Bear for the advantages of placing under a single housing, thus reducing the number of components in a system.

Regarding claim 22, Shibazaki fails to specifically disclose wherein the telecommunications network is a public switched telephone network (PSTN), wherein the telephone jack is connected to the PSTN, wherein the connection to the telecommunications network comprises a wire pair with a voltage difference between wires in the wire pair, and wherein the power for the information retransmission device is exclusively provided by the voltage difference sensed.

However, in the obvious combination, Bear discloses wherein the telecommunications network is a public switched telephone network (PSTN) (Fig. 5, reference PSTN), wherein the telephone jack is connected to the PSTN (Fig. 5; paragraph [0070]; note that the wall socket reads on the claimed telephone jack). In addition, Phillips discloses wherein the connection to the

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telecommunications network comprises a wire pair with a voltage difference between wires in the wire pair, and wherein the power for the information retransmission device is exclusively provided by the voltage difference sensed (col. 1, lines 34-50; again note that standard connections, such as the twisted pair of Phillips, inherently incorporates a wire pair with a voltage difference between wires in the wire pair).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to modify the network of Shibazaki to be a PSTN, wherein the telephone jack is connected to the PSTN, wherein the connection to the telecommunications network comprises a wire pair with a voltage difference between wires in the wire pair, and wherein the power for the information retransmission device is exclusively provided by the voltage difference sensed as suggested by Bears and Phillips for the advantages of being the standard, notoriously well-known, and widely available international telephone system.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARIVELISSE SANTIAGO-CORDERO whose telephone number is (571)272-7839. The examiner can normally be reached on Monday through Friday from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Trost/

Supervisory Patent Examiner, Art Unit
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/MARIVELISSE SANTIAGO-CORDERO/
Examiner, Art Unit 2617